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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Richard C. Willson et al.
Application NO.1 0/737,403
Filed: December 16, 2003
Attorney Docket No.: 015AUS/UH2229
Response Due: 25 April 2005

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)
)
) Art Unit

)FAX: (703)308-6916

Commissioner For Patents
Mail Stop Petitions
Box 1450
Alexandria VA 22313-1450

Sir:

Renewed Petition under 37 CFR 1.137(a) or (b)

☐ After much research, explained below, Applicants' Attorney renews the petition on different grounds. For clarity, responses are interlineated in larger type between paragraphs from the decision.

The undersigned Attorney certifies that this Document has been filed in the U.S. Post Office via Express Mail ER944923683US addressed as above to the USPTO on 18 April 2005 (37 CFR 1.10).

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COPY MAILED FEB 25 2005 OFFICE OF PETITIONS

In re Application of
Richard Coale Willson et al. Application NO.1 0/737,403
Filed: December 16, 2003
Attorney Docket No.: 015AUS/UH2229
DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed January 20, 2005, to revive the above-identified application.

The petition is DISMISSED.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on June 20, 2004, for failure to timely respond to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice") mailed April 19, 2004 which set a two (2) month period for

reply. Accordingly, a Notice of Abandonment was mailed January 6, 2005.

The response to the Notice was therefore due by 19 June 2004. When this date was inspected on the paper docket, it was just discovered that the response was marked as timely faxed to the USPTO. Finding the response on the Europe computer shows that Applicant's Attorney did timely respond. He was confused in his first response to the Notice of Abandonment because his reply was faxed from his European office and was not recorded on his US office computer. A copy of the timely response (now taken from the European computer where it was typed and faxed) is attached.

Petitioner asserts that the "Notice" was never received and thus that the delay in responding was unavoidable.

Applicant's Attorney now asserts that the Notice to File was timely responded to by fax. There were only a few incidental sequences mentioned in the Specification and the response cancelled these sequences as not being necessary to support the Claims.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a non provisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the [Page 2] issue fee or any portion thereof, the required reply must be the payment of its issue fee or any outstanding balance thereof;

(2) the petition fee as set forth in § 1.17(1);

(3) a showing to the satisfaction of the Commissioner that the entire delay filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks items (3) above.

With regard to item (3), decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only if the petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.

lin re Mattullah, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, (1887); see also

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in re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, (1887); see also

Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff'd*, 143 U.S. 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revivals made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinohoff*, 61 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quiao*, 673 F. Supp. 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). [Page 3]

Petitioner asserts that the Notice mailed April 19, 2004, was never received. A review of the record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the inventor that the Office communication was not received and attesting to the fact that a search of the docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to a referenced in petitioner's statement. 3

Petitioner has not submitted additional evidence to corroborate the allegation of non-receipt. As the showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a), the petition will be dismissed.

ALTERNATIVE VENUE

Alternative Venue should not need to be considered as the response was timely transmitted. The USPTO apparently mislaid the fax (this has happened before) and the transmission is now attached.

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), 4 which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed.

3M.P.E.P. § 711.03(c); *See* Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

[Page 4]

and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if the petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petitions Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450

By FAX:

(703)308-6916

Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned